

### REMARKS

By this Amendment, claims 3 and 14 are canceled and claims 1, 4-13, 15 and 18 are amended. New independent claim 24 is added. As a result, claims 1, 2, 4-13, and 15-24 are pending. Independent claims 1 and 7 are amended to remove the unnecessary limitation that the wire termination device comprises a plug assembly on the cover having a prong portion, and to correct certain inadvertent errors. Dependent claims 4-6 and 8-12 are amended to add the further limitation that the wire termination device comprises a plug assembly on the cover and to provide proper antecedent basis for the "prong portion." The amendments to base claims 1 and 7 broaden, rather than narrow, the scope of the claims as originally filed. The amendments to dependent claims 4-6 and 8-12 merely redefine the limitations, and thus, do not narrow the scope of claims as originally filed. Accordingly, prosecution history estoppel does not arise to bar application of the doctrine of equivalents to the amended limitations recited in claims 1 and 4-12. Independent claim 13 is amended to include the further limitation that each of the conductive contacts presents a test contact extending through the cover for placement of a test probe thereon. Dependent claim 15 is amended to provide proper antecedent basis. Independent claim 18 is amended to include the further limitation that the means for transmitting a signal is accessible through the cover while the cover is closed onto the base. New claim 24 is added to present alternative patentable limitations.

### Claim Rejections – 35 U.S.C. § 103

Pursuant to paragraphs 1 and 2 of the above-referenced Office Action, claims 1-10 and 12-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Graham et al. (5,297,199) in view of Waas (6,188,560 B1). The Examiner asserts that Graham et al. discloses a wire termination device for providing a demarcation with subscriber lines (12) comprising a base (16) having a plurality of subscriber terminals (30, 31) and a telephone jack (40) with tip and ring contacts (43, 44), a movable cover (24) associated with the base to be selectively closed thereon, a plug assembly on the cover having a prong portion that is disposed within the jack

when the cover is closed onto the base, and a conductive contact (70, 71) [sic: (71), (72)] provided on the cover that electrically connects with the jack contacts when the cover is closed. The Examiner admits that Graham et al. does not disclose the conductive contact being accessible from the exterior of the cover for providing a test contact against which a test probe may be placed to detect a telephone wiring connection. However, the Examiner further asserts that Waas discloses a multi-wire terminal block having a cover (106) provided with an external test contact element (112) adapted to receive a test probe. Therefore, the Examiner concludes that it would have been obvious to one of ordinary skill at the time of the invention to modify Graham et al. "to have [for] the conductive contact also being accessible from the exterior of the cover for providing the test contact against which the test probe as suggested by Waas in order to provide[d] convenient electrical connections between telephone customer service wires." Office Action at page 3, citing Waas, column 1, lines 19-22 (emphasis added).

Applicants respectfully traverse the rejection. There is no suggestion, motivation or teaching in the cited references to make the combination proposed by the Examiner. "In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the [teachings of the] references and combine them in the way that would produce the claimed invention." Karsten Manufacturing Corp. v. Cleveland Golf Co., 58 USPQ2d 1286 (Fed. Cir., March 22, 2001) No. 99-1234. Applicants suspect that the Examiner may have impermissibly applied hindsight to arrive at the combination of references asserted to produce the claimed invention. In the absence of any express suggestion, motivation, or teaching, it is presumed that the Examiner has utilized the disclosure of the application itself to provide the necessary suggestion, motivation or teaching. The use of Applicants' own disclosure to fill the gap between the prior art and the claimed invention is impermissible hindsight, and thus, does not satisfy the Examiner's burden to establish a *prima facie* case of obviousness.

Graham et al. discloses an apparatus for interconnecting the tip and ring wires of a subscriber premises telephone line with the tip and ring wires of a telephone company telephone line. In the art, the Graham et al. apparatus is commonly referred to as a "line module." The

Graham et al. line module includes a base (16) having a jack (40) defining a recess that houses a first pair of tip and ring contacts (43, 44) electrically connected to the subscriber terminals (30, 31) and a second pair of tip and ring contacts (48, 49) electrically connected to the telephone company line (14) via conductors (50) by terminals (51, 52). See column 4, lines 9-47. A movable cover (24) hinged to the base includes a pair of electrically conducting bridging members (71, 72). Upon closing the cover on the base, bridging member (71) is received within the jack and electrically connects the subscriber tip contact (43) with the telephone company tip contact (48). Likewise, bridging member (72) is received within the jack and electrically connects the subscriber ring contact (44) with the telephone company ring contact (49). The Graham et al. line module *does not itself* include a protection element (e.g., gas tube, metal oxide varistor, solid state device, etc.) for protecting the subscriber telephone equipment from voltage and/or current surges over the telephone line. Instead, the terminals (50, 51) may be electrically connected to a pair of telephone terminals (56, 57) mounted on an *external* electrical protection device (58). See column 4, lines 47-54 and Fig. 5. Most importantly, as stated beginning at column 8 line 65:

From FIG. 9 it will be understood that since the test leads 36 and 37 extend outwardly from the module 10, particularly with the module 10 mounted to the telephone network interface apparatus as noted above and with the mounted cover 24 fastened closed over the module base 16, telephone company personnel can attach telephone test equipment to the leads 36 and 37 to perform tests on the subscriber premises line 12, such as for example, a continuity test.

Waas discloses a multi-wire terminal block including a removable and replaceable surge protection module (100). The protection module includes a cover (106) having a reservoir (118) with slotted recesses formed therein for receiving a pair of test contact elements (112). The test contacts (112) are conductively connected to a pair of terminal block contact elements (110). When the protection module is secured to the housing (10) of the terminal block, the contact elements (110) electrically contact the test leads (48) within a test port (18) formed in the housing. The test leads (48) are electrically connected to the subscriber service tip and ring wires through cutting blades (36, 38) and to the telephone company tip and ring wires through stub cable contact element (46). Accordingly, any electrical signal available at the test leads (48) is

available at the external test contact elements (112), including the conductive path formed by the termination of the service wires and the telephone company (i.e., exchange) wires, without opening the housing (10) or disconnecting the service wires. See column 6, lines 44-48.

There is no motivation to one of ordinary skill in the art to combine the teaching of Waas with the teaching of Graham et al. Both the Graham et al. line module and the Waas terminal block permit the continuity of the conductive path between the service wires and the telephone company wires to be tested without opening the cover/housing or disconnecting the service wires. The test leads (36, 37) of the Graham et al. line module extend outwardly from the module (10) with the cover (24) closed. The test contacts (112) of the Waas terminal block extend through the cover (106) of the housing (10) into the reservoir (118). Accordingly, one of ordinary skill *would not* be motivated to modify the cover (24) of the Graham et al. line module so that the conductive contact is also accessible from the exterior of the cover to provide a test contact for receiving a test probe since the test leads (36, 37) *are already* accessible from the exterior of the line module to perform a continuity test.

As previously stated the Examiner asserts that Waas supplies the requisite suggestion, motivation or teaching to combine the references “in order to provide[d] convenient electrical connections between telephone customer service wires.” Office Action at page 3, citing Waas, column 1, lines 19-22. It is noted that having test contacts accessible from the exterior of a movable cover *does not* provide convenient electrical connections between telephone customer service wires, or drop wires, and telephone exchange distribution cables. *All* terminal blocks and line modules provide such electrical connections. In the Waas terminal block, cutting blades (36, 38) conveniently connect the subscriber service tip and ring wires to the telephone company tip and ring wires through stub cable contact element (46). In the Graham et al. line module, the convenient electrical connections are made by closing cover (24) over jack (40) such that bridging member (71) electrically connects the subscriber tip contact (43) with the telephone company tip contact (48) and bridging member (72) electrically connects the subscriber ring contact (44) with the telephone company ring contact (49). Accordingly, the Graham et al. line module *already* provides convenient electrical connections between the service wires and the

exchange wires. Furthermore, the Graham et al. line module teaches the use of an external electrical protection device, presumably for modularity and selective connection. Thus, Waas cannot be read to provide the necessary suggestion, motivation or teaching to modify the Graham et al. line module to include the removable and replaceable surge protection module (100).

Without the necessary suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select and combine the cited references in the way that would produce the claimed invention, Karsten Manufacturing Corp., the Examiner *has not* met the burden to establish a *prima facie* case of obviousness. In the absence of any such suggestion, motivation, or teaching, it is presumed that the Examiner has impermissibly applied hindsight to utilize the disclosure of the application itself to arrive at the combination of references asserted to produce the claimed invention. In either instance, the rejection is improper and must be withdrawn. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 1-10 and 12-23 under 35 U.S.C. § 103(a).

Pursuant to paragraph 3 of the Office Action, claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Graham et al. and Waas, as previously applied to base claim 7 above, and further in view of Chalmers (4,201,432). The Examiner asserts that the modified Graham et al. wire termination device discloses the claimed invention except for a flexible metal strip, but that Chalmers teaches an electrical connector having a resilient contact arm (34) which is read as a flexible metallic strip. Therefore, the Examiner suggests that it would have been obvious to one of ordinary skill at the time of the invention to modify the Graham et al. *modified* wire termination device to have the flexible metallic strip as suggested by Chalmers in order to reflect in the same direction on insertion.

Applicants respectfully traverse the rejection. Claim 11 depends from patentable base claim 7, and thus, is allowable for at least the same reasons. In particular, claim 11 is allowable because the rejection of claim 7 is improper and must be withdrawn for the reasons stated above. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 11 under 35 U.S.C. § 103(a).

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

1. (Once Amended) A wire termination device for providing a demarcation with subscriber lines comprising:

a) a base having a plurality of subscriber terminals and a telephone jack having jack contacts for interconnection with the subscriber terminals;

b) a moveable cover associated with the base to be selectively closed thereon; and

[c) a plug assembly on the cover having a prong portion that is disposed within the jack when the cover is closed onto the base, and

d]c) a conductive contact provided on the cover that is disposed within the jack when the cover is closed onto the base, the conductive contact having a portion that electrically connects with the jack contacts when the cover is closed, the conductive contact also being accessible from the exterior of the cover for providing a test contact against which a test probe may be placed to detect [wiring] electrical connections established by the wire termination device while the cover is closed.

4. (Once Amended) The wire termination device of claim 1 wherein the cover comprises a plug assembly having a prong portion and wherein the conductive contact comprises:

a bypass contact that is disposed upon an outer surface of the prong portion and positioned to avoid contact with the jack contact; and

wherein the jack has a conductive member therein that is engaged by the bypass contact when the cover is closed, the conductive member being electrically connected to the jack contact.

5. (Once Amended) The wire termination device of claim 1 wherein the cover comprises a plug assembly having a prong portion and wherein the conductive contact comprises:

a metallic strip disposed along a side of the prong portion and having an outwardly biased portion; and

wherein the jack has a conductive member on a lateral sidewall that is engaged by the metallic strip when the cover is closed, the conductive member being electrically connected to the jack contact.

6. (Once Amended) The wire termination device of claim 1 wherein the cover comprises a plug assembly having a prong portion and wherein the conductive contact extends to a lower side of the prong portion and is positioned to physically contact the jack contact when the cover is in the closed position.

7. (Once Amended) A wire termination device comprising:

a) a base having a telephone jack with tip and ring contacts for establishing a telephone wiring connection;

b) a cover hingedly secured to the base to be selectively closed and opened thereupon; and

[c) a plug assembly retained by the cover, the plug assembly having a prong portion to be received within the jack and to thereby engage the tip and ring contacts to establish the telephone wiring connection when the cover is closed onto the base;

d)]c) a pair of conductive contacts provided on the cover to be received within the jack when the cover is closed onto the base, each being recessed within a cavity that is open to the exterior of the cover for providing a test contact against which a test probe may be placed to detect an electrical signal indicative of [a] the telephone wiring connection established by the wire termination device[; and

e)], each conductive contact having a conductive portion [located on the prong portion] for making an electrical connection with one of the tip and ring [contact wires] contacts while the cover is in a closed position.

8. (Once Amended) The wire termination device of claim 7 wherein the cover comprises a plug assembly having a prong portion and wherein each of the conductive contacts comprises a metallic strip extending upwardly from the prong portion of the plug assembly to present the test contact proximate an upper portion of the plug assembly.

9. (Once Amended) The wire termination device of claim 7 wherein the cover comprises a plug assembly having a prong portion and wherein each of the conductive contacts comprises:

a bypass contact that is disposed upon an outer surface of the prong portion and positioned to avoid contact with the tip and ring contacts; and

wherein the jack has a pair of conductive members therein that are engaged by the bypass contacts when the cover is closed, the conductive members being electrically connected to the tip and ring contacts.

10. (Once Amended) The wire termination device of claim 7 wherein the cover comprises a plug assembly having a prong portion and wherein each of the conductive contacts comprises:

a metallic strip disposed along a side of the prong portion and having an outwardly biased portion; and

wherein the jack has a conductive member on a lateral sidewall that is engaged by the metallic strip when the cover is closed, the conductive member being electrically connected to the jack contact.

11. (Once Amended) The wire termination device of claim 7 wherein the cover comprises a plug assembly having a prong portion and wherein each of the conductive contacts comprises:

a flexible metallic strip having a contacting portion that is biased outwardly from a lateral side of the prong portion.

12. (Once Amended) The wire termination device of claim 7 wherein the cover comprises a plug assembly having a prong portion and wherein each of the conductive contacts comprises:

an electrically conductive member that extends to a lower side of the prong portion and is positioned to physically contact the tip and ring contacts when the cover is in the closed position.

13. (Once Amended) A wire termination device comprising:

a base having a subscriber terminal assembly thereupon;

a jack containing tip and ring contacts [or electrically interconnection] for establishing electrical connections with the subscriber terminal assembly;

a movable cover for the base, the cover having a plug portion that is removably inserted into the jack when the cover is closed onto the base; and



a pair of conductive contacts provided on the cover, each of the conductive contacts being electrically interconnected with the subscriber terminal assembly and presenting a test contact extending through the cover for placement of a test probe thereon.

15. (Once Amended) The wire termination device of claim [14] 13 further comprising a pair of test probe access holes in the cover to permit the test probe to contact each test contact.

18. (Once Amended) A wire termination device comprising:

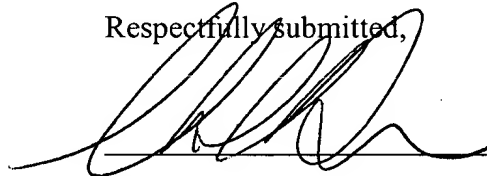
- a) a base having a telephone jack thereupon for establishing a telephone wiring connection;
- b) a cover associated with the base to be selectively closed thereon; and
- c) means for transmitting a signal indicative of [an established] the telephone wiring connection, the means for transmitting a signal accessible through the cover while the cover is closed onto the base.

**CONCLUSION**

In view of the foregoing amendments and remarks, reexamination and reconsideration of the application is respectfully requested. This Amendment being fully responsive to the Office Action, Applicants submit that the application is now in condition for immediate allowance and solicit such favorable action on the part of the Examiner. The Examiner is encouraged to contact the undersigned directly to further the prosecution of any remaining issues, and thereby expedite allowance of the application.

This Amendment results in one (1) additional independent claim, but does not result in more total claims than were paid for previously. Accordingly, a fee for one (1) independent claim in excess of the number paid for previously is due. The Examiner is hereby authorized to charge such fee, and any other fees due in connection with the filing of this response, to Deposit Account No. 19-2167. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not already accounted for, such an extension is requested and the fee should also be charged to Deposit Account No. 19-2167.

Respectfully submitted,



Christopher C. Dremann  
Attorney for Applicants  
Registration No. 36,504  
P. O. Box 489  
Hickory, N. C. 28603  
Telephone: 828/901-5904  
Facsimile: 828/901-5206

Dated: \_\_\_\_\_

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